REMARKS

This Amendment is prepared in compliance with 37 CFR §1.133(b), and in accordance with the discussion during the Office interview with the Examiner held on Wednesday, the 2nd of November 2005, and in response to the final Office action mailed on 22 November 2005 (Paper No. 11152005).

Office Interview – 37 CFR §1.133(b)

On the 2nd of November 2005, and Office interview was held with the Examiner; during the course of the interview, the Examiner offered several observations and made various suggestions for advancing the compacted prosecution of the above-captioned application in view of the Examiner's comments set forth in the first Office action mailed on 13 April 2005 (Paper No. 04072005). The following paragraphs include a complete written statement of the reasons presented at the interview as warranting favorable action, as well as amendments of claim 1 as discussed during the interview, amendments of claim 16 prepared for discussion during the interview, and claims 17 through 23 which were also prepared for discussion during the interview.

Status of the Claims

Claims 1 through 6, 8, 9, 10, 14, 15 and 16 are amended, and claims 17 through 23 are newly presented. Claims 1 through 23 are pending in the application.

Amendment of Claims 1 and 16

During the Office interview, the Examiner requested amendment of claim 1 to

substitute –device– for "means." Claim 1 is amended in accordance with the Examiner's request. A comparable amendment is made to the term *conveyor* in claim 16, by substituting *conveyor assembly* for *conveyor*, in keeping with what Applicant's undersigned attorney understood to be the intent, and concomitant request, of the Examiner's request for amendment of claim 1.

Objection to the Drawings under 37 C.F.R. §1.83(a)

The drawings are objected to under 37 C.F.R. §1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner required indication of the conveyor elements, insertion stations, adhesion stations, collection stations, and conveyor devices in the drawings. As explained during the Office interview, the objection is unfounded in each of the four instances noted by the Examiner's comments.

In the first instance, the attention of the Examiner was invited during the Office interview to note that "conveyor elements" is used collectively to refer, in the aggregate, to the several constituent components of the various conveyors described in the *Detailed Description*, several of which components are individually shown in the drawings.

In the second instance, the attention of the Examiner was directed during the Office interview to note that rather than the nominative phrase "insertion station" mentioned in Paper No. 04072005, Applicant illustrates "inserting station 58", with some degree of detail, in Figure 3. Moreover, the *Brief Description of the Drawings*, among other portions of Applicant's specification, expressly identifies this feature.

In the third instance, the Examiner questioned that absence of "adhesion stations" and "collection stations" in the drawings. During the Office interview, it was noted that these various assemblies are conventional, and their respective connections to Applicant's invention are duly represented by the, insertion station illustrated in Figure 3, in compliance with the last clause of 37 CFR §1.83(b), and as also indicated by "straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100", together with "drying station 102" illustrated as rectangular boxes in Figure 9 of Müller '278.[1] As explained in paragraph [0010] of Applicant's original specification, "adhesive binding is shown in detail in EP-A1-0675005." Although Figure 3 represents an inserting station which is located "radially on the inside"[2], what is significant here is the "large accessibility radially on the inside as well as radially on the outside and from the side ... possible to provide further working stations along the revolving path 31 ... ."[3] Figure 3 provides an exemplary degree of illustration of these connections between these different constituent components of Applicant's inventions, in conformance with the last clause of 37 CFR §1.83(b). Accordingly, reconsideration of this requirement is respectfully requested. Should, upon reconsideration, the Examiner deemed that amended drawings are necessary, or even desirable, Applicant will submit additional

---

1 See column 8, lines 27 through 65 of Müller, U.S. Patent No. 5.562.278, which is assigned to the instant Applicant.

2 Original Specification, paragraph [0047], line 3.

3 Original Specification, paragraph [0047], lines 2 and 3.

figures using boxes to represent "adhesion stations" and "collection stations".

In the fourth instance, the Examiner questioned the absence of "conveyor devices" in the drawings. The Examiner was invited during the Office interview to note "conveyor device 30" "among features shown in Figure 5.

During the interview, Applicant's attorney observed that insertion station 58 illustrated in detail by Figure 3 is a representative of other types of "work stations", in compliance with both the last clause of 37 CFR §1.83(b) and the convention followed by the U.S. Patent & Trademark Office in Müller '278; by way of example, Figure 7 of Müller '278 shows a "straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100 [which] are arranged one behind the other along the upper stand 72 ... [and] a drying station 102." Each of "straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100 [and] drying station 102" is represented by a rectangular box. Although 37 CFR §1.83(b) requires no more, Applicant here has additionally illustrated the details of a representative work station and illustrated the

Applicant has prepared in conformance with the Examiner's request, and encloses herewith, Figure 8, showing a sequence of individual working stations 92, 94, 96, 98, 100 and 102. Confirmation is subsequent Office correspondence is solicited to confirm Applicant's filing and the Office's acceptance of a formal drawing illustrating Figure 8.

Objection to the Abstract

The Abstract was objected to as containing the word "means." The Abstract was amended in Applicant's response filed on the 13th of October 2005, and "means" was deleted. As agreed during the Office interview, this removed the basis for this objection, and this objection is now moot.

Claim Rejection Under 37 C.F.R. §112

Claims 1 through 15 are rejected under the second paragraph of 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With the exception below noted, claims 8, 9, 10, 12, 14 and 15 are amended to omit those phrases questioned by the Examiner.

As explained during the Office interview, in the one exception, the Examiner questioned the presence of "means" in claim 1, and asserted that "it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph." Contrary to this assertion, the scope of claim 1 is determined by the prior art, and not by a notion of equivalents. Moreover, the sixth paragraph of 35 U.S.C. §112 is permissive, and places no requirement for inclusion of specific limitations in any claim; nothing in pending claim 1 violates the sixth paragraph of 35 U.S.C. §112. Although this rejection is not supported by any provision of the sixth paragraph of 35 U.S.C. §112, during the Office interview, the Examiner requested amendment of claim 1 to substitute –device– for "means." Claim 1 is amended in accordance with the Examiner's request. Accordingly, withdrawal

of this rejection is respectfully urged.

Claim Rejection Under 35 U.S.C. §102(b)

Claims 1 through 15 are rejected under 35 U.S.C. §102(b) as being anticipated by Müller, U.S. Patent No. 5,562,278. Applicant traversed this rejection in the response timely filed on the 13th of October 2005. During the Interview, Applicant's undersigned attorney explained that the rejection was unsustainable for the following reasons.

1. Paper No. 04072005 does not teach every element of claims 1 through 15 or newly presented claims 17 through 23, as is demanded to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b).

Under current U.S. Office practice established by 35 U.S.C. §102(b), no claim may be rejected under 35 U.S.C. §102(b) unless:

> "[t]he identical invention ... [is] shown in as complete detail as
>
> is contained in the ... claim".[4]

In support of this rejection however, the Examining staff argues that,

> "The applicant states that Muller does not disclose that the conveyor means in the transfer region is arranged adjacent to a collection drum end of the collection drum. the Examiner disagrees with the applicant. As the applicant states in the specification in paragraph [0010] in describing an European equivalent of Muller, Muller discloses, *The revolving conveyor*

---

[4] §2131 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 3, August 2005, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

means is arranged adjacent to the collection drum end."[5]

This rationale endeavors to justify a denial of patentability by focusing exclusively upon a single phrase in claim 1, "wherein the conveyor device in the transfer region is arranged adjacent to a collection drum end of the collection drum", and a single phrase in claim 16, "a conveyor assembly arranged adjacent to a collection drum end of the collection drum". 35 U.S.C. §102(b) however, demands evidence that "the invention was patented or described in a printed publication" while the second paragraph of 35 U.S.C. §112 defines the states that the claims define "the subject matter which the applicant regards as his *invention.*" Applicant is concerned that the focus by the Examining staff upon a single phrase in claims 1 and 16, and a comparison of those phrases with the Background discussion of Applicant's original specification[6] is somewhat less evidence of anticipation that contemplated by 35 U.S.C. §102(b), particularly in view of the failure of the Examining staff to consider the remainder of claims 1 and 16. The adjective *adjacent* is known for its breath and scope as a description of spatial relations; the fact that the same adjective may be used to broadly describe attributes of both the existing art and the Applicant's invention is not persuasive evidence of anticipation under 35 U.S.C. §102(b).

By way of a first demonstration, claim 1 defines a structure in which, "for the second rests movable in the conveyor path there is provided a conveyor unit detached from the

---

5 Paper No. 11152005, page 3.

6 Applicant's original specification states that [t]*he revolving conveyor means is arranged adjacent to the collection drum end.*", page 6, lines 1 and 2.

collection drum" while claim 16 defines a structure with "a conveyor unit detached from the collection drum". A structure with these attributes is wholly absent from the Müller '278 patent; in contradistinction, the Müller '278 patent teaches that:

> "[t]he separating elements 42 are spaced apart by a distance A, and are carried by an endless drawing member 46, for example two chains 46'... the endless conveyor member 46 or chains 46' are guided around **the supporting element 16 of the processing drum 14** and a cylindrical drum-like deflection member 48."[7]

Where is any suggestion of "detached" in the prior art? In other words, the art represented by the Müller '278 patent is incapable of teaching Applicant's structure with "a conveyor unit detached from the collection drum."[8] Where is the completeness of a demonstration of anticipation required under 37 CFR §1.104(a), (b) and (c)?[9]

By way of a second demonstration of a lack of anticipation under 35 U.S.C. §102(b), claims 1 and 21 define:

> "the conveyor ~~means~~ device in the transfer region is arranged adjacent to a collection drum end of the collection drum in a manner such that the printed products may be transferred from the collection drum end to the conveyor ~~means~~ device or vice versa",[10]

---

7 The significance of this passage of Müller '278 is the integration of circulating conveyor 40 and processing drum 14, wholly devoid of Applicant's teaching of "a conveyor unit detached from the collection drum."

8 Claim 1, lines 15 and 16, and claim 16, line 10.

9 Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 3, August 2005.

10 Claim 1, lines 15 and 16.

while claim 16 defines,

> "a conveyor assembly arranged adjacent to a collection drum end of the collection drum to accommodate transfer of the printed products between the collection drum end and the conveyor assembly".[11]

Newly presented independent claim 17, prepared for discussion during the Office interview, reads,

> "a conveyor assembly selectively alignable spaced-apart from an end of the collection drum to accommodate transfer of the printed products between the terminal portion and the conveyor assembly",[12]

while Applicant's newly presented independent claim 19 reads,

> "a conveyor assembly positionably spaced-apart from said terminal portion to rotate around a second axis displaceable from coaxial alignment with said drum axis to accommodate to within a transfer region of the collection drum, transfer of printed products between the first rests and a plurality of second rests borne by the conveyor assembly".[13]

Müller '278 however, describes a structure with,

> "**At a first end section** of the processing drum, folded printed products can be deposited in a straddling manner on wall elements of the processing drum by a gripper conveyor. **At a second end section**, located ***at the other end of the processing***

---

[11] Claim 16, line 10.

[12] Claim 17, lines 8 and 10.

[13] Claim 19, lines 9 to 13.

> ***drum***, printed products that have been processed in the processing drum are removed by a gripper conveyor."[14]

In its broadest interpretation made without benefit of its drawings, this excerpt from the Müller '278 patent might arguably read as positioning a "gripper conveyor" at one end of processing drum 14 to remove printed products from a central portion of processing drum 14 neighboring that "gripper conveyor"; where is any suggestion of Applicant's teaching of a transfer of "the printed products ... from the collection drum end to the conveyor ~~means~~ device" or "transfer of the printed products between the collection drum end and the conveyor assembly"? Such deficiencies is persuasive evidence of an utter lack of anticipation. Paper No. 04072005 simply does not address every element of claims 1 through 16 as is demanded to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b); moreover, as demonstrated in the foregoing paragraphs, claims 17 through 20 prepared for discussion during the Office interview are readily allowable over the prior art. Withdrawal of this rejection is therefore required under guidance laid down by the Director for the Examining staff.[15]

2. Paper No. 04072005 fails to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b).

First, 35 U.S.C. §102(b) states that an Applicant shall be entitled to a patent unless

---

[14] Müller, et al. '527, column 1, lines 10-23.

[15] §2131 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 3, August 2005.

the invention the invention was patented or described in a printed publication ... ." Paper No. 04072005 misrepresents the subject matter described in the Müller '278 patent; specifically, in an effort to support the rejection under 35 U.S.C. §102(b), the Examining staff wrote that,

> "Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)[16] with uniformly distributed saddles (18) and conveyor elements (34); conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46"); a conveyor unit (48); and working stations (82, 74)."[17]

In the language of 35 U.S.C. §102(b), the Examining staff is asserting that Applicant's invention as defined by the pending claims, was patented by Müller '278. Ignoring *arguendo* the question of whether the foregoing excerpt from the Paper No. 04072005 is a true characterization of Müller '278, the excerpt is not faithful to the definition of Applicant's inventions set forth in claim1 or in newly presented claim 16. Moreover, as is demonstrated in the paragraphs below, this statement is not supported by the evidence of record in this application. Full consideration of all of the evidence of record is required in making a determination of whether Applicant's invention is anticipated under 35 U.S.C. §102(b).

Second, in point of fact, Applicant defines, *inter alia*,

> "a collection drum rotatingly drivable about its drum axis and comprised of first rests with first saddles, said first rests being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum

---

16 In point of fact, Müller '278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

17 Paper No. 04072005, page 4.

> axis, as well as conveyor elements for conveying the printed products on the first saddles in the axial direction along the firsts rests, and
>
> comprising a conveyor device which comprises a conveyor path with a conveyor direction which at least in a transfer region deviates from the axial direction as well as second rests, movable in the conveyor path, with second saddles arranged distanced to one another and arranged transversely to the conveying direction,
>
> wherein the conveyor device in the transfer region is arranged adjacent to a collection drum end of the collection drum in a manner such that the printed products may be transferred from the collection drum end to the conveyor or vice versa,
>
> wherein for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum."

By way of example of the failure to demonstrate anticipation, there is no indication in Paper No. 20050610 of where Müller '278 either teaches a *conveyor device* that "in the transfer region is arranged adjacent to a collection drum end of the collection drum" or teaches that "for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum." Instead, Müller '278 states that,

> "**At a first end section** of the processing drum, folded printed products can be deposited in a straddling manner on wall elements of the processing drum by a gripper conveyor. **At a second end section**, located ***at the other end of the processing drum***, printed products that have been processed in the processing drum are removed by a gripper conveyor. The apparatus has, one behind the other, a multiplicity of sections to which processing and/or feeding stations are associated. The feeding stations are designed to deposit folded printed products in a straddling manner on top of the printed products which have already been deposited on the wall elements or to introduce inserts, at the correct page, into the compartments defined by the

wall elements."[18]

Although this excerpt from Müller '278 describes Honnegar, U.S. Patent 5,324,014, the general concept of a "processing drum" is incorporated into Müller '278, which teaches that:

> "[t]he processing drum 14 has, at its end region on the left-hand side in FIG. 1, a first feeding section 22.1 and, at the other end region on the right-hand side of FIG. 1, a removal section 24."[19]
>
> ...
>
> "The circulating-conveyor section 26 is associated with a circulating conveyor 40 which functions to guide the printed products which have been fed to it from the feeding section 22.3 ... for carrying out specific processing steps on the printed products 10, and to guide the latter back to said processing drum 14 ... ."[20]

This structure with circulating conveyor 40 deployed between the first feeding section 22.1 at the "end region on the left-hand side in FIG. 1" and "a removal section 24" located "at the other end region on the right-hand side of FIG. 1," is the antithesis of the structure defined by claims 1 and 16; although Müller '278 particularly identifies and details both of the opposite ends of his processing drum14, nowhere does Müller '278 teach a *conveyor device* that "in the transfer region is arranged adjacent to a collection drum end of the collection drum."

Third, Müller '278 further teaches that,

---

[18] Müller, et al. '527, column 1, lines 10-23.

[19] Müller, et al. '527, column 3, lines 38-40.

[20] Müller, et al. '527, column 4, lines 19-25.

> "[t]he separating elements are spaced apart by a distance A, and are carried by an endless drawing member 46, or example two chains 46'. the endless conveyor member 46 or chains 46' are guided around the supporting element 16 of the processing drum 14 and a cylindrical drum-like deflection member 48." [21]

Claims 1, 16 and 17 define "for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum",[22] "a conveyor unit detached from the collection drum, disposed to propel the second rests along the conveyor path",[23] and "a conveyor unit detached from the collection drum and disposed to propel the second rests along the conveyor path,"[24] features which a wholly lacking among the specification of Müller '278. Consequently *the invention*[25] has been neither patented nor described in a printed publication at any time prior to Applicant's filing date. Withdrawal of this rejection is therefore required.

3. The Examining Staff has failed to comply with the requirement of 37 CFR §1.104(b) and (c) for completeness of Paper No. 20050610.

First, Paper No. 20050610, in its entirety, avers that,

---

21 Müller '278, column 4, lines 32-38.

22 Pending claim 1.

23 Pending claim 16.

24 Pending claim 17.

25 35 U.S.C. §102(b).

> "Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)[26] with uniformly distributed saddles (18) and conveyor elements (34); conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46"); a conveyor unit (48); and working stations (82, 74)."[27]

Nowhere does Paper No. 20050610 address such features set forth in the express language of claim 1, as, by way of example, Applicant's *conveyor device* that "in the transfer region is arranged adjacent to a collection drum end of the collection drum" or teaches that "for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum." These are also features of newly presented claims 17 through 20.

Second, claim 1 defines a structure in which, "for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum" while claim 16 defines a structure with "a conveyor unit detached from the collection drum"; in contradistinction, the Müller '278 patent teaches that:

> "[t]he separating elelments 42 are spaced apart by a distance A, and are carried by an endless drawing member 46, for example two chains 46'... the endless conveyor member 46 or chains 46' are guided around **the supporting element 16 of the processing drum 14** and a cylindrical drum-like deflection member 48."[28]

---

[26] In point of fact, Müller '278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

[27] Paper No. 04072005, page 4.

[28] The significance of this passage of Müller '278 is the integration of circulating conveyor 40 and processing drum 14, wholly devoid of Applicant's teaching of "a conveyor unit

Where is any suggestion of "detached" in the prior art? In other words, the art represented by the Müller '278 patent is incapable of teaching Applicant's structure with "a conveyor unit detached from the collection drum."[29] Where is the completeness of a demonstration of anticipation required under 37 CFR §1.104(a), (b) and (c)?[30] Written clarification in compliance with 37 CFR §1.104(a), (b) and (c) is respectfully requested in a non-final Office action.

Third, Müller '278 describes a structure with,

> "**At a first end section** of the processing drum, folded printed products can be deposited in a straddling manner on wall elements of the processing drum by a gripper conveyor. **At a second end section**, located ***at the other end of the processing drum***, printed products that have been processed in the processing drum are removed by a gripper conveyor."[31]

In its broadest interpretation made without benefit of its drawings, this excerpt from the Müller '278 patent might arguably read as positioning a "gripper conveyor" at one end of processing drum 14 to remove printed products from a central portion of processing drum 14 neighboring that "gripper conveyor"; where is any suggestion of Applicant's teaching of

---

detached from the collection drum."

29 Claim 1, lines 15 and 16, and claim 16, line 10.

30 Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 3, August 2005.

31 Müller, et al. '527, column 1, lines 10-23.

a transfer of "the printed products ... from the collection drum end to the conveyor ~~means~~ device" or "transfer of the printed products between the collection drum end and the conveyor assembly"? Such deficiencies is persuasive evidence of an utter lack of anticipation. Paper No. 04072005 simply does not address every element of claims 1 through 16 as is demanded to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b) with the degree of completeness adequate to demonstrate of anticipation required under 37 CFR §1.104(a), (b) and (c)?[32] Written clarification in compliance with 37 CFR §1.104(a), (b) and (c) is respectfully requested in a non-final Office action, in order to accord Applicant an opportunity to respond, contradict or explain any errors found in that clarification.

Fourth, where in Müller '278 is there found "a device for collecting and processing folded printed products that includes a collection drum (14)"? Müller '278 identifies a *processing* drum 14, but not a *collection* drum 14. Is this discrepancy in nomenclature simply a typographic error in Paper No. 20050610? Müller '278 is quite clear that with his novel "processing drum",

> "*certain* processing steps on the printed products ... are no longer carried out in the processing drum ... ."[33]

Honnegar '014 also describes,

---

[32] Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8th Ed., Rev. 3, August 2005.

[33] Müller '278, column 2, lines 10-13.

> "an elongate processing drum 12 which is mounted rotatably about its horizontal access 14 ... on a machine frame 18 ...[with] a multiplicity of wall elements 22, which are arranged approximately in axial planes, extend over the entire processing length of the processing drum 12 and are evenly distributed, seen in the circumferential direction ... [with] saddle-shaped rests 24, which run parallel to axis 14 ... in order to advance the printed products 10 deposited in a straddling manner on the rests 24 ... [past] twelve feed stations 30 arranged next to one another along the processing drum 12." [34]

In contradistinction, Applicant explains that in the art such as that represented by EP-A1-0675005,

> "The collection drum in the usual manner surged the collection of the printed products. The collected printed products are transferred to the revolving conveyor means and here may be subjected to further working steps, *i.e.* adhesive binding or stapling, wherein adhesive binding is shown in detail in EP-A1-0675005."[35]

and as is explained by Honegger *et al.* U.S. 5.324.014, the text of which patent is expressly incorporated into Müller '278 [36],

> "[t]he apparatus, which carries out the process, has a processing drum driven rotationally ab out a horizontal axis, and a plurality of saddle-shaped rests are distributed regualrly about the drum in the circumferential direction." [37]

---

[34] Honneger U.S. patent 5,324,014, column 4, lines 39-69.

[35] Applicant's original specification, page 5, lines 13-16.

[36] See Müller '278 at column 1, beginning with line 8.

[37] Honneger U.S. patent 5,324,014, column 1, lines 53-57.

This rejection therefore rests upon the entirety of an inaccurate characterization of the prior art as represented by Müller '278, namely the assertion that,

> "Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)[38] with uniformly distributed saddles (18) and conveyor elements (34) ... ."[39]

This is inaccurate because Müller '278 itself, expressly teaches that:

> "[a]ccording to the invention, certain processing steps on the printed products or the addition of further products to the printed products are no longer carried out in the processing drum, but in a circulating conveyor."[40]

It is unclear why the Examining staff has argued that "Müller discloses a device for collecting and processing folded printed products", when Müller '278 itself denies that certain processing steps are carried out on his processing drum; given this discrepancy, Paper No. 04072005 fails to meet the requirements for completeness required under 37 CFR §1.104(b) and (c). Written clarification in subsequent Office correspondence is respectfully requested, to particularly identify where Müller '278 "discloses a device for ... processing folded printed products." Absent this, the rejection fails to make a *prima facie* demonstration under 35 U.S.C. §102(b) of either the patenting or description in a printed

---

38 In point of fact, Müller '278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

39 Paper No. 04072005, page 4.

40 See Müller '278 at column 2, lines 9-12.

publication of Applicant's invention prior to the date of this application.

Fifth, the Examining staff continues in this vein by asserting that:

> "Müller discloses a ... conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46"); a conveyor unit (48); and working stations (82, 74)."[41]

This assertion of the Examining staff is contradicted by the express teachings of Müller '278. In point of fact, Müller '278 expressly states that the:

> "circulating conveyor 40 has separating elements 42 which correspond to wall elements 18 of the processing drum 14 and separate receiving compartments 44, which correspond to the compartments 32 of the processing drum 14."[42]

Wholly absent from this teaching are both of the Examining staff's (*i*) "conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46")" and (*ii*) "conveyor means (40) with second saddles (42)", as well as the Examining staff's (*iii*) "conveyor means (40) with second saddles (42), having bending devices". Does the Examining staff intend to refer to "rest saddle 52"?[43] It is unclear why the Examining staff has argued that,

> "Müller discloses ... conveyor means (40) with second saddles

---

41 Paper No. 04072005, page 4.

42 Müller '278 at column 4, beginning with line 19.

43 Müller '278, column 4, line 59.

> (42), having bending devices, in a transfer region (50') supported on rails (46")", when Müller '278 states that reference numeral 42 refers to "separating elements 42" and that "separating elements 42 ... correspond to wall elements 18";

given these discrepancies, Paper No. 04072005 fails to meet the requirements for completeness required under 37 CFR §1.104(b) and (c). Written clarification in subsequent Office correspondence is respectfully requested, to particularly identify where:

(*i*) Müller '278 "discloses ... conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46")",

(*ii*) Müller '278 "discloses ... conveyor means (40) with second saddles (42)", and

(*iii*) Müller '278 "discloses ... conveyor means (40) with second saddles (42), having bending devices".

Absent clarification in conformance with the requirements for completeness under 37 CFR §1.104(b) and (c), the rejection fails to make a *prim a facie* showing of obviousness under 35 U.S.C. §103(a).

4. The Examining Staff has failed to comply with the requirement under 35 U.S.C. §102(b) by considering the entirety of the subject matter which the Applicant regards as "the invention."

Müller '278 claims priority from Swiss patent No. CH19940001316 199440428, and was published as EP0681979 (B1). The evidence of record, as set forth in Applicant's original specification, identified Müller '278 as EP-B1-0681979.[44] As explained by Applicant in paragraph [0010] of the original specification, Müller '278 contemplates a structure with,

> "[o]ne possibility for the flexible use of space for various working steps is disclosed in EP-B1-061979. With this device for collecting and processing folded printed products a collection drum is combined with a revolving conveyor means. The collection drum in the usual manner serves the collection of the printed products. The collected printed products are transferred to the revolving conveyor means and here may be subjected to further working steps, *i.e.*, adhesive binding or stapling, wherein adhesive binding is shown in detail in EP-A1-0675005. The axial direction of the collection drum and the conveyor direction in the revolving conveyor means ... [being] perpendicular to one another ... . On collection of the printed products these are moved along on the rests to a first collection drum end. The collection drum end is determined by the end of the rests of the collection drum. **The hub of the collection drum on the other hand extends beyond the end of the collection drum.** The revolving conveyor means is arranged adjacent to the collection drum end. Chains which serve as conveyor devices in the revolving conveyor means and engage radially on the inside of its rests are led around that part of the hub projecting beyond the collection drum end. **This part of the hub thus serves as diverting means in the revolving conveyor means and thus becomes an integral part of this.** A ***common drive*** thus simultaneously provides for the rotation movement of the collection drum and for the conveyor movement of the rests in the revolving conveyor means. The

---

[44] Original specification, paragraph [0010], lines 11 and 12.

> distance between the rests moved in the revolving path is dimensioned such that these, when they are conveyed in the region of the collection drum, are flush with the rests of the collection drum, by which means a simple transfer of the printed products from the collection drum to the revolving means, based on the same design, may be transferred to a further collection drum arranged displayed to the first collection drum but may also be led back to the first collection drum on a lover side ... of the revolving conveyor means and transferred to a further collection section of the first collection drum."[45]

The difficulty with the structure disclosed in Müller '278 is then discussed by Applicant in paragraph [0011]:

> "[a]lthough this design permits a higher flexibility of the use of space, however with this device too the use of the space is ***restricted*** since the folded printed products in each case may only be transferred in the diverting region of the revolving conveyor means from the collection drum to the conveyor means and from the conveyor means to the collection drum."[46]

In contradistinction, claims 1 and 16 define a structure in which "the conveyor means in the transfer region is arranged adjacent to a collection drum end of the collection drum ... ." This feature is not found in Müller '278. Under 35 U.S.C. § 102(b), it is error to assume that two structures are the same or equivalent simply because they perform the same function. The Federal Circuit has held it error to assume that two structures are the same or equivalent simply because they perform the same function. *Roton Barrier, Inc. v. Stanley Works,* 79 F.3d 1112, 1126-27 (Fed. Cir. 1996); *Pennwalt Corp. v. Durand-Wayland, Inc.,* 833 F.2d 931, 934

---

[45] Original specification, paragraph [0010]; emphasis added.

[46] Original specification, paragraph [0011].

(Fed. Cir. 1987) (en banc) ("Pennwalt erroneously argues that, if an accused structure performs the function required by the claim, it is per se structurally equivalent"), *cert. denied,* 485 U.S. 961 (1988). Infringement (or anticipation) is found only if the claimed function is performed by either the same structure (or acts) that the specification describes or else by an equivalent of the structure (or acts). *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1562, 231 USPQ 833, 834-35 (Fed. Cir. 1986). Accordingly, this rejection is improper under the all elements rule. Withdrawal of the rejection and allowance of claims 1 through 16 is respectfully requested.

In summary, this rejection rests upon an inaccurate characterization of the prior art as represented by Müller '278, such as the assertion by the Examining staff that,

> "Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)[47] with uniformly distributed saddles (18) and conveyor elements (34) ... ",[48]

is inaccurate because Müller '278 itself expressly teaches that with a *processing drum*:

> "[a]ccording to the invention, certain processing steps on the printed products or the addition of further products to the printed products are no longer carried out in the processing drum, but in a circulating conveyor",[49]

---

[47] In point of fact, Müller '278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

[48] Paper No. 04072005, page 4.

[49] See Müller '278 at column 2, lines 9-12.

while Applicant teaches that a *collection drum* is not a device for collecting **and** processing folded printed products as averred by the Examining staff. Applicant explains a *collection drum* as serving "the collection of printed products ... [and the] collected printed products are transferred to the revolving conveyor and here may be subjected to further working steps, i.e. , adhesive binding or stapling ... ."[50] The technique of the Examining staff for formulating a rejection under 35 U.S.C. §102(b) by inaccurately characterizing the teachings of Müller '278 will not support a rejection under 35 U.S.C. §102(b), because the Examining staff has simply attributed the language of claims 1 through 16 to Müller '278 without any demonstration that Applicant's invention as defined by the pending claims, was patented by Müller '278. Consequently, the rejection fails to make a *prima facie* demonstration under 35 U.S.C. §102(b) of either the patenting or description in a printed publication of Applicant's invention prior to the date of this application. Withdrawal of this rejection and allowance of claims 1 through 23 is respectfully urged.

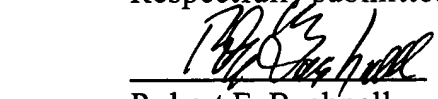
It is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

---

[50] Applicant's specification, page 5, lines 14-17.

A fee of $550.00 is incurred by the addition of two (2) independent claims in excess of 3 and three (3) total claims in excess of total 20. In addition, a fee of $450.00 is incurred by filing of a Petition for a two-month extension of time. Applicant's check drawn to the order of Commissioner accompanies this Amendment After Final. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56988
Date: 4/24/06
I.D.: REB/kf